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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/668,701
Filing Date: September 23, 2003
Appellant(s): STEWART ET AL.

John LaBatt
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/23/10 appealing from the Office action mailed 8/24/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

A related application, U.S. Application No. 09/709,433, was previously appealed to the Board of Patent Appeals and Interferences (Appeal 2007-3345) and a decision was rendered by the Board on June 16, 2008.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The After final amendment filed on 11/23/09 was entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence related Upon*

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US 6,615,234 Adamske et al. 09/02/2003

US 6,134,568 Tonkin 11/6/2001

US Publication 2001/0043753 Grohs et al. 11/22/2001

(9) *Grounds of Rejection*

1. Claims 24-47 are still provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-33 of copending Application No. 09/709,433. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the current application and copending are drawn to a method of previewing a document. (i.e. Claim 24 recited a generating a print file (reads on generating as recited in claim 12 of '433); transmitting and receiving the print file from the server (reads claim 12 recited on the obtaining the print file from the server as recited by '433) ; and displaying the image data in an interface at the client in response to the receiving (reads on the providing the preview for display at the client. Claim 12 of '433 teaches using a system software, not a print driver. However claim 13 of '433 teaches that the use of the system software as a print driver. Therefore, It would have been obvious to one of ordinary skill at the time to provide substitute the system software as the print driver as described in claim 13 of '433 in order to use a printer that can be use by different print drivers, therefore improving the versatility of the printer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claims 24-47 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for generating and transmitting print files and prompting the user without any further user interaction after the request to print. The specification does not enable any person skilled in the art to which it pertains,

or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The specification at no point discusses performing all of the steps of "automatically transmitting" and "without user initiated interaction with the server" as recited in claims 24 and 36. In fact, the specification actually discusses that a user would have to manually log in to the system between the steps of generation and transmission (page 23, lines 9-14 of applicant's specification).

3. Claims 24-28,30-39 and 41-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (6,615,234) in view of Tonkin (6,314,568).

With regard to claim 24, Adamske et al teaches a method of previewing a document (e.g. abstract)) a document, comprising: generating a print file on a client based on the document using a print driver executing on a client in response to a print request for the document designating the print driver (e.g. fig. 3, and col. 7, lines 16-44); and displaying the image data in an interface at the client based on the transmitted print file (e.g. col. 2, lines 4-60). Adamske et al teaches automatically user uploading or transmitting and receiving the print file to the server without user initiated interaction with the server (col. 5, lines line 64- thru col. 7, line 15, clearly once the file is received the configuration wizard can send it to the server, no user interaction is needed). Adamske et al fails to teach the displaying image data generated by the server and provided to the user based on the print file that was transmitted or uploaded. However, Adamske et al.discloses an alternate method in which the server generates a preview

based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske et al.). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

With regard to claims 25 and 26, Adamske et al. fails to teach selecting a print driver and displaying a list of print drivers on the client; and choosing a desired print driver. Adamske et al. discloses a method in which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske et al.). Adamske et al. does not the selecting of the print driver. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske et al. because it would have allowed the user to see the format type the print file would be in.

With regard to claim 27, Adamske et al. further teaches obtaining step includes transmitting the print driver to the client over the network (reads on fig. 1-3).

With regard to claim 28, Adamske et al further teaches creating the document using an application installed on the client (see abstract).

With regard to claim 30, Adamske et al. teaches verifying the print driver (application) the transmitting step (e.g. col. 3, lines 47-63).

With regard to claim 31, Adamske et al further teaches selecting file information

associated with the print file using the interface (reads on fig. 3).

With regard to claim 32, the limitations of claim 32 are covered by the limitations of claim 24 above; and Adamske et al further teaches the upload manager (reads on fig. 9 for transmitting the print file (e.g. col. 5, lines line 64- thru col. 7, line 15).

With regard to claim 33, Adamske et al further teaches a version manager for verifying the print driver before transmitting the print file ((e.g. column 5, line 64-column 7, line 15).

With regard to claim 34, Adamske et al further teaches an application for creating the document, wherein the application is installed on the client (reads on figs 1-3 and abstract)

With regard to claim 35, Adamske et al further teaches a wide area network, and the Internet (e.g. fig. 1-3).

With regard to computer program claims 36-39 and 41-42, the steps of the computer claims 36-39 and 41-42 read on the steps of the method claims 24,25,27-31 are describe above. The method steps of claims 24,25 and 27-31 can be program and store in the memory (208,209 or 232) of Adamske et al to create computer programs of claims 36-39 and 41-42.

With regard to claim 43, Adamske et al further teaches wherein the print file comprises a postscript file (see abstract).

With regard to claims 44-46, Adamske et al further teaches selecting a finishing option (e.g. binding) for the document, wherein the image data is further based on the selected finishing option (reads on fig. 3).

With regard to claim 47, the limitations of claim 47 are covered by the limitations of claim 43 above.

4. Claims 29 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (6,615,234) as applied to claims 24 and/or 32 above, and in further view of Grohs et al. (2001/00433753).

With regard to claim 29, Vidyanand teaches the communication of data between the client and printer (see fig. 1), but fails to explicitly teach compressing the print file before transmitting step. However, Grohs et al. (in the same field of endeavor "data processing" teaches that it is well known in the art to compress the print file before transmitting it [0032]. Therefore, it would have been obvious to one of ordinary skill in the art to provide the system of Vidyanand with the ability of compressing the data as taught by Grohs et al. because of the following reasons; 1) as suggested by Grohs et al. in paragraph [0032]. To reduce time and resources, and 2) to allow the system of Cooper et al. to send the data a lot faster by compressing large files before transmitting them.

With regard to computer program claim 40, the steps of the computer claim 40 read on the steps of the method claim 29 above. The method steps of claims 40 can be program and store in the memory (208,209 or 232) of Adamske et al to create computer

programs of claims 40.

(10) Response to argument

*With regard to Applicant's **argument** with respect to the rejection of claims 24-47 under 35 USC 112, first paragraph. Applicant cited specification , p. 18 and fig. 7, 605,610 and PP. 20-21 and fig. 9, 506,532, do not support the limitation of "automatically transmitting" and "without user initiated interaction with the server". Examiner has reviewed the cited portions and has not found support for the features of "automatically transmitting" and "without user initiated interaction with the server" . Also Examiner has read applicant's specification and conducted a search of the US publication 2004/005705 (equivalent to this application) using the terms "automatic\$4 adj3 transmit\$4" or "initiat\$4 adj4 interaction") were not found or described in the specification or drawings. And Examiner asserts that Adamske et al teaches automatically allowing the user to uploading or transmitting and receiving the print file to the server without user initiated interaction with the server (reads on col. 5, lines line 64- thru col. 7, line 15, which clearly suggests that once the file is received the configuration wizard can send it to the server, and no user interaction is needed, the process is done automatically).*

With regard to Applicant's argument that the proposed combination of Adamske and Tonkin fails to teach or suggest automatically transmitting a print file for processing by a server over a network in response to generating the print file without user-initiated interaction with the server as claimed therein. Examiner disagrees with Applicant's

conclusion. Clearly fig. 1 of Adamske clearly suggests that a user can generate or create a print file using computer 10, fig. 2, also depicts how host computer 11 can generate a print file that can be send to the printer 40, through a server 20, and fig. 3, depicts how a user can create the file to be send or transmitted to a server to be printed by a printer, and col. 7, lines 16-44, describe how a print driver program (10) stored at the client side (or computer) is used to create or generate a file.

With regard to Applicant's argument that Adamske does not teach a user uploading a print file which can be printed automatically by the server, and that the server is the converting the file. Examiner disagrees with Applicant's conclusion. Examiner asserts that Adamske does teach the user uploading the print file to a server (see col. 3, lines 53-57) and that the print file received by the server is processed (or converted) automatically to a file that can be received by a destination (printer), the user does not have to select the format of the file the server process the file received and send the preview to the user when the file is converted (see col. 3, lines 64 thru col. 4, line 8 and col. 5, lines 14-46). Clearly the user (or host computer) does not process the file in the proper format to be deliver, the translation server does the conversion automatically without user intervention (see col. 5, lines 14-46). Clearly the user can convert the file to a print file, the user selects a destination, but the user does not have to worry about the format of the print file the server will convert the file to the proper format and send the preview to the user.

Claims 32 and 36 have similar arguments.

(11) Related Proceeding(s) Appendix

Appeal brief does not identify any related proceeding(s)

(12) Oral Argument

Appeal brief does not contain any oral arguments.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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